UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,889	11/05/2003	R. Mark Halligan	7208-90742	7856

24628 7590 04/10/2008

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/10/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/701,889
Filing Date: November 05, 2003
Appellant(s): HALLIGAN ET AL.

Jon P. Christensen
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on December 13, 2007 **for further consideration of a rejection**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal 2007-2973

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claims 1 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2003/0158745), in view of Rotter et al (US 2003/0046280).

Claims 2-26 and 28-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2003/0158745), in view of Rotter et al (US 2003/0046280), in further view of Jacobson et al (USPN 6,167,397).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0158745	Katz et al	08-2003
USPN 6,167,397	Jacobson et al	12-2000
US 2003/0046280	Rotter et al	03-2003

(9) NEW GROUND(S) OF REJECTION

The following new grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2003/0158745), in view of Rotter et al (US 2003/0046280).

As per claim 1, Katz et al disclose a method of discovering trade secrets of an organization (i.e., system for a company to develop and maintain intellectual capital, ¶ 0005), such method comprising the steps of: collecting sets of descriptive information about potential trade secrets through an input device of a computer from a plurality of persons of the organization (i.e., user enters information regarding new innovation via tab 500, ¶ 0040), analyzing the collected sets of descriptive information about potential trade secrets using logical and mathematical formulae (i.e., executing a query via innovation query page 120 to determine matching entries of the search query, ¶¶ 0052-53), and generating a report containing the non-redundant descriptive information about potential trade secrets of the organization (i.e., innovations folder 600, containing one entry for each innovation, ¶ 0043).

Katz et al does not disclose identifying and eliminating any redundancy among the sets of descriptive information about potential trade secrets to define a collection of descriptive information about potential trade secrets of the organization. Rotter et al disclose identified potential duplicate records grouped into record sets for merging into a composite surviving record and for data processing by process 210, wherein process 210 merges identified duplicate records based on predetermined user definable rules

and wherein the merge rules are determinable by a user to ensure data considered to be the most reliable is retained in a surviving record and inconsistent or redundant data is removed (¶ 0021). It would have been obvious to one of ordinary skill in the art to include in the dynamic network database of intellectual property of Katz et al (¶ 0005) the ability to identifying and eliminating any redundancy among the sets of descriptive information as disclosed by Rotter et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 27 is rejected based upon the same rationale as the rejection of claim 1, since it is the programmed computer claim corresponding to the method claim.

Claims 2-26 and 28-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US 2003/0158745), in view of Rotter et al (US 2003/0046280), in further view of Jacobson et al (USPN 6,167,397).

As per claim 2, Katz et al disclose correlating among the sets of descriptive information about potential trade secrets having at least some redundant entries to identify sets of descriptive information about potential trade secrets that are related by redundancy and sets of descriptive information about potential trade secrets that are unrelated (i.e., the innovation query page 1200 allows the user to execute searches based upon various attributes of the abstract, ¶ 0050). Neither Katz et al nor Rotter et al explicitly disclose integrating redundant entries among the respective sets into

compiled sets of descriptive information about potential trade secrets with non-redundant entries that together with the sets of descriptive information about potential trade secrets with unrelated entries define a collection of descriptive information about potential trade secrets. Jacobson et al provides for clustering of documents (i.e., trade secret information) matching queries based on occurrence of terms, whereby weighing the terms using a standard measure results in identification of a small number of clusters (i.e., defining a collection of similar documents, column 2, lines 46-52). Further, Jacobson et al disclose an infrequent matching, where a document and record may be joined based on a high probability of being semantically related (column 7, lines 6-10). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include integrating redundant entries with non-redundant entries in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 3 and 6, Katz et al disclose conducting interviews of each person of the plurality of persons over an electronics communications network (e.g., information acquired from users via network 10, ¶ 0033).

As per claim 4, Katz et al disclose downloading a web form containing a plurality of information entry fields that request trade secret information from each person of the plurality of persons (i.e., users accesses web pages via user interface and access new innovation page 500, ¶¶ 0039, 0043).

As per claim 5, Katz et al disclose collecting information from each person of the plurality of persons regarding the identities of a plurality of other persons who may have information about the trade secrets of the organization (i.e., peernet access link 618 that allows users to locate and store profiles of professionals with expertise in the particular innovation, ¶ 0058).

As per claim 7, Katz et al disclose downloading a web form containing a plurality of information entry fields that request said identities from each person of the plurality of persons (i.e., users accesses web pages via user interface and access peernet access link 618 that allows users to locate and store profiles of professionals with expertise in the particular innovation, ¶¶ 0043, 0058).

As per claim 8, Katz et al disclose collecting information from each person of the plurality of persons regarding the locations of the trade secrets of the organization (i.e., locations of trade secrets may be found in innovations folder 600, ¶ 0043).

As per claim 9, Katz et al disclose conducting interviews of each person of the plurality of persons over an electronics communications network (i.e., user entered information, based on template of main page 40 and new innovation page 500, maintained by network administrator, ¶¶ 0038-39).

As per claim 10, Katz et al disclose downloading a web form containing a plurality of information entry fields that request said information on locations from each person of the plurality of persons (i.e., users accesses web pages via user interface and innovations folder 600, ¶¶ 0043-44).

As per claim 11, Katz et al disclose the step of correlating further comprises matching respective information entry fields of the plurality of fields of the trade secret information entries and marking trade secret information entries with matching fields as belonging to a single potential trade secret group (i.e., matched entries are listed in order of relevance to the search terms and saved in the internal abstracts folder based on the selected innovation, ¶ 0057).

As per claim 12, Katz et al disclose a field for a subject matter of the trade secret (i.e., abstract 1204, ¶0050).

As per claim 13, Katz et al disclose a field for a format of the trade secret (i.e., general classification 1214, ¶ 0050).

As per claim 14, Katz et al disclose a field for a product or service enhanced by the trade secret (i.e., applications, ¶ 0050) .

As per claim 15, Katz et al disclose the step of correlating further comprises performing key word searching of the plurality of fields of each potential trade secret group (i.e., user submits search query S104 and determines where to search S106, figure 14).

As per claim 16, neither Katz et al nor Rotter et al disclose improving the performance of said correlation by replacing any keywords encountered that are associated with a corresponding master keyword in a table of synonym keywords with the corresponding master keyword. Jacobson et al disclose an attribute/value index, wherein a collection of attributes is stored (i.e., master index) and matched at a later time, similar to a table to synonym keywords. In addition, Jacobson et al discloses the

clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a table of synonym keywords in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 17-18, neither Katz et al nor Rotter et al disclose subdividing each potential trade secret group into more specific sub-groups based on the analysis of keywords contained in the plurality of fields and where each sub-group has at least a predefined number of keywords in common. Jacobson et al disclose documents clusters created and scored based upon the diversity of matches of documents (column 3, lines 12-15). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the analysis of keywords where each sub-group has at least a predefined number of keywords in common in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 19-20, neither Katz et al nor Rotter et al disclose using common keywords from keyword fields of multiple potential trade secret entries and using non-common keywords and their frequency of occurrence in the keyword field of multiple potential trade secret entries being integrated as a common/non-common keyword field in the resulting non-redundant trade secret entry. Jacobson et al disclose determining

the similarity between documents by determining the co-occurrence of infrequently occurring (i.e., non-common) terms in the vicinity of query (i.e., common) keywords (column 3, lines 63-67). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include using common and non-common keywords and their frequency of occurrence in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 21-23, neither Katz et al nor Rotter et al disclose forming predetermined mathematical quantities, an arithmetic mean, or a standard deviation to represent a characteristic value and an error range for each numerical field of the plurality of trade secret entries being integrated. Jacobson et al disclose using statistically and logarithm analysis to achieve a flattening effect that gives importance to the number of term occurrences (column 3, lines 37-41). In addition, Jacobson et al discloses the clustering of documents employed as a post search analytical tool (column 6, lines 19-23), thereby supplementing the Katz et al innovations query page 1200 (¶ 0050). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include forming predetermined mathematical quantities, an arithmetic mean, or a standard deviation to represent a characteristic value and an error range in Katz et al, as seen in Jacobson et al, as an efficient means of searching in a set of structured documents.

As per claims 24-26, Katz et al disclose generating data mining signatures, content filtering signatures, or electronic document scanning signatures from the collected trade secret information, or by the results of logical or mathematical formulae applied thereto (i.e., various levels of access determine how much of each entry can be viewed, based upon password and user-defined access control, ¶¶ 0034, 0041).

Claims 28-52 are rejected based upon the same rationale as the rejections of claims 2-26, since they are the programmed computer claims corresponding to the method claims.

(10) Response to Argument

In the Board of Patent Appeals and Interferences decision entered December 13, 2007 (Appeal 2007-2973), the Board stated that "...we remand this application to the Examiner for consideration of whether it would have been obvious to modify the art of record to utilize the method of eliminating redundancy in a database by removing or deleting redundant entries, admitted by Appellants to be known in the art (Finding of Fact 10), and whether such modification renders claims 1-52 unpatentable. See e.g., KSR, 127 S.Ct. at 1740 ('[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.')" See page 9.

In addition, the Board stated that "[a]ppellants contend that the present invention "is distinguished from prior art that eliminates redundancy in other types of databases

because the claimed invention operates without any need for the unique identifiers that simplify identifying duplicate or redundant entries and eliminating the redundancy in the other types of databases" (Appeal Br. 9). However, we note that at least independent claim 1 does not recite any of the features of the present invention which allow it to operate without the need for unique identifiers. Further, we suggest that the Examiner determine, if he has not done so already, whether any such prior art systems that eliminate redundancies in databases operate without the requirement of a unique identifier." See pages 9-10.

As such, and in light of the Board's suggestions, the Examiner submits Rotter et al as disclosing eliminating redundancy in a database by removing redundant entries without the requirement of a unique identifier, based upon the merge rules, as discussed in the above rejection.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings. A Technology Center Director or designee has approved this supplemental examiner's answer by signing below.

Respectfully submitted,

Andre Boyce
April 15, 2008

Conferees:

Vincent Millin, Appeals Practice Specialist

DIRECTOR, TC 3600

Beth Van Doren, Primary Examiner
Art Unit 3623

ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600